

BEST AVAILABLE COPY**Remarks**

Reconsideration of the application and allowance of all pending claims are respectfully requested in view of the remarks below. Claims 1-8, 10-14, 16-33, 35-39, 41-60, 62-66 and 68-76 remain pending.

Finality of Rejection

In an Advisory Action dated April 19, 2004, the proposed amendments in applicants' reply dated March 26, 2004 would not be entered because they were allegedly deemed to not place the application in better form for appeal by materially reducing or simplifying the issues for appeal. As further noted in the Advisor Action, the explanation given as to how the new or amended claims would be rejected was that the applicants are attempting to differentiate the amended claims from the prior art based on the use of the term "enterprise resource management" and that the term ERP is allegedly broad and encompasses the automation/computerization of various standard workflow manufacturing processes, and therefore, the prior art allegedly continues to read on the applicants' claims.

Applicants filed a Request for Continued Examination (RCE) to continue this application and to have claim amendments entered and considered.

However, to applicants' surprise, instead of continuing to work with the applicants to advance prosecution of the application, the Examiner issued a First Office Action Final for the RCE. This First Office Action Final reiterates the above explanation and the arguments in the last Office Action (dated January 27, 2004).

Applicants respectfully submit that the finality of the Office Action is improper. As stated in MPEP 706.07:

While the rules no longer give to an applicant the right to "amend as often as the Examiner presents new references or reasons for

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rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the Examiner to that end, and not be prematurely cut off in the prosecution of his or her application. ...

The Examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

Additionally, MPEP §706.07(b) indicates that it is not proper to make final a first Office Action in a continuing application, where that application contains material which was presented in the earlier application after final rejection, but was denied entry because new issues were raised that required further consideration and/or search. Applicants made substantive claim amendments in a bona fide attempt to advance prosecution of this application. Applicants respectfully submit that the Examiner, at the very least, implied that the proposed claim amendments would not be entered because they would not reduce or simplify the issues for appeal, and thus, raise new issues. Therefore, applicants, in an effort to move this case along, opted to file an RCE. Since the Examiner led applicants to believe that the claim amendments would require further consideration, applicants respectfully submit that the finality of the first Office Action is improper.

Therefore, applicants respectfully request a withdrawal of the finality of the July 14, 2004, Office Action, or, at the very least, meaningful consideration of the remarks below.

Status Of Claims

The amendment to the claims proffered in the RCE was entered.

Summary Of The Invention

Applicants' invention is directed to the managing of information such as contracts. In particular, the invention relates to identifying information, for example retrieving data inherent to the contract's subject, from an Enterprise Resource Planning System in a private electronic environment, managing the information in a public electronic environment, and registering the managed information via the public electronic environment with the private electronic environment.

Advantageously, aspects of the present invention minimize access to the back-end system (e.g., the ERP systems) of a private electronic environment by pre-fetching data from the back-end system and storing it on the web server of a public electronic environment. This data is then used to create and/or maintain proposals on the front-end system. This enables the information to be worked-on in a user-friendly environment, and does not require the user to stay connected to the private electronic environment. When a proposal is complete, it is then forwarded to the back-end system (private electronic environment) for contract fulfillment, invoicing and accounting.

For example, the invention may be a complex seller-driven experience for large enterprise level contracts like a contract for maintenance and upgrade of a large number of equipment or more generally a contract which replaces multiple recurring payments (related to software licenses or services) with a single unique contract.

Issues

1) Whether claims 1-8, 10-23, 25-33, 35-48, 50-60, 62-74, and 76 rejected under 35 U.S.C. §102(b) are anticipated by Walker et al. (U.S. Patent No. 5,794,207).

2) Whether claims 24, 49, and 75 are obvious to one of ordinary skill in the art based on the teachings/suggestions of Walker et al. (U.S. Patent No. 5,794,207).

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Argument

Applicants respectfully, but most strenuously, submit that since at least one feature of applicants' claimed invention is missing from the applied reference (and as noted below there are many features missing), Walker et al. would not anticipate applicants' invention, nor render applicants' invention obvious.

As noted above, applicants' invention is directed to the managing of information such as contracts. In particular, the invention relates to identifying information, for example retrieving data inherent to the contract's subject, from an Enterprise Resource Planning System in a private electronic environment, managing the information in a public electronic environment, and registering the managed information via the public electronic environment with the private electronic environment. Neither of these elements or functions is shown nor taught in Walker et al. as described in greater detail below.

Walker et al. is directed to a one-time simple buyer-driven electronic experience compared to applicants' invention that is directed to a complex negotiated seller-driven experience.

In the background section in columns 1-4, Walker et al. describe a typical seller-driven experience, a typical exchange-driven experience, and a typical buyer-driven experience. Importantly, a key point described in column 3, lines 19-26, of Walker et al. is that individual consumers cannot effectively participate in a bilateral buyer-driven experience because they don't have the buying power of a large organization. Sellers are deterred to respond to individual RFP because there is no guarantee of the authenticity of the RFP and the cost of negotiating with individual consumers (lines 48-53 column 3). A key element necessary to achieve a critical mass of seller participation in such bilateral electronic buyer driven system is the seller's ability to bind a buyer to a legal contract under the term of the buyer posted offer (lines 13-27, column 4).

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The object of Walker et al. is a system of buyer-driven electronic commerce that offers the capability for individual buyers to issue authenticable messages that contain the term of a purchase offer. Publish the offer to potential sellers. Allow a seller who meets the terms and conditions to bind the buyer to accept the seller fulfillment of the offer and collect the funds immediately, upon the seller's acceptance of the buyer's terms. Walker et al. also disclose allowing a third party (who will own/administer the system which is called a controller) to supervise the transaction (column 7, line 26 to column 8, line 25).

The steps in the technique disclosed in Walker et al. may be summed up as follows:

- Step 1 - the prospective buyer sends a RFP to the controller;
- Step 2 - the controller automatically authenticates the buyer data;
- Step 3 - the controller automatically sends the request to perspective sellers; and
- Step 4 - the controller automatically creates the contract and cash in for the seller.

In contrast to the buyer-driven experience of Walker et al., applicants' invention is directed to a seller-driven experience where the buyers are generally large organizations. The object of the transaction is, for example, a contract that for its nature to be planned, simulated, negotiated and fulfilled needs the most current data and specifications related to a contract's subjects. Generally subjects of the contract are performances and/or specifications of equipments and/or software and/or services.

This information is generally sensitive for both buyer and seller and is recorded in the private electronic environment of the buyer or the seller or both. Performances and/or specifications of equipments, software or services, which are the subject of these kinds of contracts, keep changing depending on the business needs of the buyer. Consequently there is a need for fetching current data from the private electronic environment where this information is stored, which is normally the ERP system of the seller or buyer or both.

To make a concrete example in the first implementation of applicants' invention, the contract's subject may be for software. The software may be normally paid with recurring payments while the recurring (monthly or quarterly) price varies depending on certain price drivers like the number of users or the computer processor power where the software is installed. A company may maintain records of these data in its private electronic environment (ERP system). Other possible applications are any sort of complex services or maintenance contracts: Maintenance of equipment (photocopiers, airplanes, car fleet etc) where the contract's subject is the equipment's specifications and the maintenance service specifications.

In these cases, both the buyer and seller have an interest in negotiating an umbrella contract that covers the whole budget cycle (usually a year). In addition, the buyer may have the flexibility to change during the budget cycle, whether the buyer will effectively buy or request terms of service performance or specifications within certain parameters established when the contract is signed. Because of the umbrella contract the buyer will receive a bottom line invoice. The administrative saving and business flexibility that both seller and buyer have as a result of this kind of contracts may be substantial.

The steps in the technique of applicants' invention may be summed up as follows:

Step 1 - information is identified, via a public electronic environment, from an enterprise resource planning system within a private electronic environment, e.g., data stored for a contract in an ERP system in a private environment is made available and accessed using a public electronic environment;

Step 2 - the information is managed, wherein one or more aspects of managing the information are performed within the public electronic environment off-line from the private electronic environment, e.g., the buyer and the seller negotiate the terms of the contract; and

Step 3 - the managed information is registered, via the public electronic environment, with the private electronic environment.

First, Walker et al. fail to disclose "identifying information to be managed." As noted above, Walker et al. disclose a buyer posted offer. This offer is not to be managed but simply accepted by the seller. In applicants' invention, for example, after fetching data from the ERP system of the seller, the seller needs to work with the buyer to plan its future needs and simulate various planning scenarios and various contract options. The information fetched will be used as a base for planning and simulation. The purpose of the planning phase is to determine the buyer requirements for the next planning cycle. In the example of the software business which has been used in our implementation buyer and seller will work together in answering the following questions: Which new software will be installed and when? Which one will be removed and when? On which computer will the software be installed? How many users will use it? Which support and maintenance services are requested and for how long? The simulation activity is in support of planning because it allows foreseeing the effect of different planning scenarios on the price/performance of the contract.

Walker et al. in addition to failing to disclose "identifying information to be managed", also fail to disclose "managing the information" and "registering the managed information" as recited in applicants' independent claims.

Thus, Walker et al., which fail to disclose these features, would not have anticipated applicants' invention as recited in independent claims 1, 19, 26, 44, 51-53, and 71.

Second, the final Office Action (page 2, section 2) notes that applicants were attempting to differentiate the amended claims from the prior art based on the use of the term "enterprise resource management." Further stated in the final Office Action (page 2, section 2) was that the term ERP is allegedly broad and encompasses the automation/computerization of various standard workflow manufacturing processes, and therefore, it is the Examiner's responsibility to

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give claim language its broadest reasonable interpretation, and thus, the prior art (Walker et al.) allegedly continues to read on the applicants' claims.

However, the final Office Action (page 2, section 2) fails to identify an ERP system in Walker et al. If the controller for regulating the buyer driven transaction in Walker et al. is to be taken, for the sake of argument, as the ERP system, then as noted below, the controller is neither operated in a private electronic environment nor designed to support and automate the business processes of a business.

As an ERP system cannot be found in the applied prior art, the limitation of an ERP in applicants' independent claims does indeed differentiate applicants' invention from Walker et al. Thus, Walker et al., which fail to disclose an ERP system, would not have anticipated applicants' invention as recited in independent claims 1, 19, 26, 44, 51-53, and 71.

Third, noted in the final Office Action (page 2, section 2) is also that applicants argue that the limitation regarding private and public information is not present in the prior art of Walker et al.

However, applicants did not simply argue that the limitation of private and public information is not present in the prior art of Walker et al. Instead applicants argued that Walker et al. fail to identify information from an ERP system within a private electronic environment, and further identify information from an ERP system within a private electronic environment via a public electronic environment. See, page 15 of applicants' Response dated March 26, 2004.

Thus, Walker et al. which fail to disclose identify information from an ERP system within a private electronic environment would not have anticipated applicants' invention as recited in independent claims 1, 19, 26, 44, 51-53, and 71.

Fourth, in the final Office Action (page 2, section 2), it is the Examiner's position that the term "private electronic environment" is extremely broad and it is the Examiner's responsibility

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to give claim language its broadest reasonable interpretation, and that the central controller of Walker et al. is a private electronic environment as the public does not have access to its data stores (figure 2).

However, on the next page of the final Office Action (page 4, section 4), the Examiner takes the opposite position. In particular, the Examiner states that Walker et al. teach a method for managing information comprising: managing information within a public environment offline from the private environment (figures 2, 6 and 20, column 12, line 8-21 and 40-53 column 14, lines 33-39; column/line 22/39-23/19; column 27, lines 20-43).

As there is only one system in Walker et al., the fact is, Walker et al. disclose a public electronic environment that has access to private information, and not a private electronic environment operating an ERP (e.g., software system that is designed to support and automate the business processes of medium and large businesses). Further, in Walker et al., the transaction start and end in the central controller administered from a third party outside of any private electronic environment of seller and buyer (if there are any), and in any event, there is no interaction between such public and the private networks.

In addition, as noted above, the private electronic environment of applicants' invention is an ERP system that contains data inherent to the contract's subject and not a controller that has the purpose to regulate the buyer driven transaction as described in Walker et al. A controller, as stated in a standard English dictionary, means, "regulating mechanism, as in a vehicle or electric device". That is exactly the purpose of the controller in Walker et al. to regulate the buyer driven transaction. The Examiner should not mischaracterized it and consider a controller similar to an ERP system. An ERP (Enterprise Resource Planning) system is any software system designed to support and automate the business processes of medium and large businesses.

Thus, Walker et al. which neither disclose a private electronic environment nor an ERP system operating in a private electronic environment would not have anticipated applicants' invention as recited in independent claims 1, 19, 26, 44, 51-53, and 71.

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Fifth, another factor not addressed in Walker et al. is where applicants' system allows the negotiation and the preparation of the proposal completely off-line or disconnected from the private electronic environment. Thus, Walker et al. would not have anticipated applicants' invention as recited in independent claims 1, 19, 26, 44, 51-53, and 71.

Sixth, the controller in Walker et al. does not fetch any information from buyer and seller. It receives information and administers information coming from both buyers and sellers. In applicants' invention, the server in the public electronic environment accesses the ERP system in the private electronic environment and selects specific information that is needed as a base for the contract. Nothing of this kind is described in the Walker et al. Thus, Walker et al. which do not disclose "pre-fetching data from said private electronic environment to be use in the managing of said information" would not have anticipated applicants' invention as recited in dependent claims 17, 42, and 69.

Seventh, another factor not addressed in Walker et al. is administration of the approval process before registering the proposal as a contract in the private electronic environment. This is typical in the case of multimillion enterprise level contracts where strict approval level authorization signature processes have to be defined and controlled to guarantee the desired level of approvals. As noted above, in Walker et al., the seller need only accept to create the contract. Thus, Walker et al. would not have anticipated applicants' invention as recited in dependent claims 10, 12, 35, 46, 62, and 73.

35 U.S.C. §103(a) Rejection

In the Office Action, claims 24, 49, and 75 were rejected under U.S.C. §103(a) as allegedly being unpatentable over Walker et al. (U.S. Patent No. 5,794,207). Applicants respectfully traverse this rejection for the following reasons.

As noted above, Walker et al. fail to disclose "an enterprise resource planning system within a private electronic environment", as well as identifying or obtaining information, "via a public electronic environment, from an enterprise resource planning system within a private electronic environment to be managed." More importantly, Walker et al. fail to teach or suggest "an enterprise resource planning system within a private electronic environment" and identifying or obtaining information, "via a public electronic environment, from an enterprise resource planning system within a private electronic environment to be managed."

In addition, Walker et al. do not address the problems associated with enterprise resource planning (ERP) systems, and in particular, the problem of performing one or more aspects of managing information, and in particular, information obtained from an ERP system in a private electronic environment, within a public electronic environment, rather than the private electronic environment.

For the reasons noted above, Walker et al. fail to teach or suggest methods, systems, and computer products as recited in the amended independent claims. It is respectfully submitted therefore that applicants' invention, as recited in the claims presented is patentable over Walker et al.

Conclusion

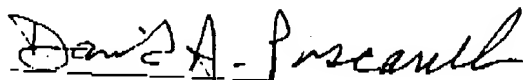
It is believed that the application is in condition for allowance, and such action is respectfully requested.

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If a telephone conference would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,



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